IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of:) MMB Docket No.: **1776-0035**

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Inventor: **Neville et al.**   ) Xerox Docket No.: **D/A 2554**

)

Application No.: **10/648,414**   ) Examiner: **Melvin H. Pollack**

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Filed: **August 26, 2003**   ) Group Art No.: **2145**

)

For: **Peripheral Device Diagnostic**   ) Confirmation No.: **4003**
       Method And Architecture   )

CORRECTED APPEAL BRIEF SECTION

Hon. Commissioner of Patents and Trademarks
Alexandria, VA 20231

Sir:

In response to the Notification of Non-Compliant Brief, Applicant submits a corrected version of the brief section found to be defective by the Patent Appeal Center Specialist. Although Applicant thought the brief originally filed fully complied with the rules, a corrected brief section is presented below to address the Notification of Non-Compliant Appeal Brief. Section 7 of the brief is also

being submitted as that section was affected by the changes to section 6, which was the subject of the Notice of Non-Compliance.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The first ground of rejection to be reviewed on appeal is whether claims 1-3, 5-9, 12-14, and 16-20 are unpatentable under 35 U.S.C. 103(a) over Assauchi (U.S. Patent Number 7,013,410, hereinafter "Assauchi") in view of Skaanning et al. (U.S. Patent Number 6,879,973, hereinafter "Skaanning") and Wolff (U.S. Patent Number 6,209,048, hereinafter "Wolff").

The second ground of rejection to be reviewed on appeal is whether claims 4 and 15 are unpatentable under 35 U.S.C. 103(a) over Assauchi and Skaanning and Wolff, and in further view of Webb et al. (U.S. Patent Number 5,727,135, hereinafter "Webb").

The third ground of rejection to be reviewed on appeal is whether claims 10, 11, 21, and 22 are unpatentable under 35 U.S.C. 103(a) over Assauchi and Skaanning and Wolff, and in further view of Lozano et al. (U.S. Patent Number 7,168,003, hereinafter "Lozano").

(7) ARGUMENT

The rejected claims do not stand or fall together.

First Ground of Rejection under 35 USC 103: Whether the cited combination of Assauchi, Skaanning, and Wolff arrive at a peripheral diagnostic system or

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method that communicates between a backend server and a web server in a peripheral through a browser executing in a computer coupled to the peripheral as required by claims 1-3, 5-10, 12-14, and 16-21.

CLAIMS 1-3, 5-10, 12-14, and 16-21

In order to establish a *prima facie* case of obviousness the Examiner must rely upon facts gleaned from the cited references. *MPEP* 2142. Knowledge of the applicant's disclosure must be put aside to avoid the use of impermissible hindsight in manipulating the references to arrive at the claimed invention. *Id.* As set forth in more detail below, the facts presented in the cited references do not arrive at a backend server and a web server in a peripheral coupled to a computer executing a web browser communicating with one another by forwarding messages through the browser. Therefore, the Examiner has not established that Applicant's claimed invention is an obvious combination of known elements or an obvious modification of a known system or method.

The Examiner relies upon the three way combination of U.S. Patent No. 7,013,410 to Assauchi (hereinafter "Assauchi") in view of U.S. Patent No. 6,879,973 to Skaanning et al. (hereinafter "Skaanning") and U.S. Patent No. 6,209,048 to Wolff (hereinafter "Wolff"). The Assauchi reference uses the word "browser" only once. The word is used to describe a representative program executing in a computer. The computer is coupled directly to a printer and is also coupled through the internet to a support center. *Assauchi*, col. 4, lines 15-20; FIG. 1. Communication between the user and the support center and between the printer and the support center occurs, however, through the client side agent.

Assauchi, col. 7, lines 53-67; col. 8, lines 29-41; FIG. 10. Nowhere is the client side agent identified as being a browser. Additionally, Assauchi does not disclose any communication between the client side agent and the server side agent within the HTTP protocol. More importantly, Assauchi does not teach that a web server executing in a peripheral device coupled to a computer executing the browser sends a peripheral device HTTP message to the web browser and that message is forwarded to the backend server or that an automatic response with another peripheral device HTTP message having functionality information occurs in response to a directive web page, which was constructed and send by the backend server, being received at the web server as required by claims 1, 6, and 12.

Skaanning discloses a system in which a customer uses a web-browser executing in a computer coupled to a printer to interact with a diagnostic system operating at a web server to troubleshoot printer problems. The *customer* may obtain data from either the printer or the printer server to respond to the diagnostic system through the web-browser/web server link. *Skaanning*, col. 8, line 58 - col. 9, line 5; col. 9, lines 16-21; FIG. 3. This description means the data obtained from the printer or the printer server is in human readable form and entered by the customer into the queries and/or directions, which are also in human readable form, obtained from the web server through the browser. Thus, Skaanning teaches that a person can use a web browser to relay the *content* of messages received at a web browser from either a peripheral device or a diagnostic system. The reference does not teach, however, that the web browser

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relays the received messages themselves as required by the claimed invention.

Moreover, Skaanning does not show the web server executing in a peripheral. In fact, the only server on the side of the computer executing the web browser is a printer server 209. That server, however, executes outside of the printer 210. Thus, Skaanning only teaches two party communication between the web server and the web browser/customer *or* between the printer and the web browser/customer. Consequently, Skaanning does not teach that a web server executing in a peripheral device coupled to a computer executing the browser sends a peripheral device HTTP message to the web browser and that message is forwarded to the backend server or that an automatic response with another peripheral device HTTP message having functionality information occurs in response to a directive web page, which was constructed and sent by the backend server, being received at the web server as required by claims 1, 6, and 12. Combining the two references does not make the missing limitations appear without some imaginative application of Applicant's specification. Such usage is impermissible hindsight.

Wolff does not save the deficient combination. In Wolff, a peripheral is provided with a web server, which enables users to communicate and obtain data directly from the peripheral device through forms identified by Universal Resource Locators (URLs). The web server in Wolff provides direct communication with other computers through the internet. This feature enables the web server to dispense with the need for a host computer. *Wolff*, col. 10, lines 25 – 33. In fact, the web server of Wolff was developed to address the

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issues raised by having a peripheral device communicate through a host computer to which the peripheral device is attached. *Wolff*, col. 2, lines 34-58. Thus, one of ordinary skill would apply Wolff by directly coupling the web server in the peripheral to a network to communicate with, not through, a web browser in a remote computer as shown in FIG. 2. Consequently, Wolff teaches away from the invention of claims 1 and 6. In fact, applying the teachings of Wolff to the combination of Assauchi and Skaanning would result in the web server of the peripheral being coupled to the internet for direct communication with the backend server to enable the backend server to control the peripheral remotely and iteratively obtain the necessary data for diagnosing the peripheral. The web browser and its operation would, therefore, be superfluous and removed from the system all together.

The Examiner, however, adds Wolff to the Assauchi/Skaanning combination in a manner that retains the web browser because he is using Applicant's specification as a blueprint. Such usage is impermissible and cannot properly support a *prima facie* case of obviousness. What the Examiner does is add the peripheral having a web server to the combination of Assauchi and Skaanning to create a system in which the computer executing the web browser is coupled to the peripheral having the web server through one network and the computer with the browser is also coupled to the backend server through the same or another network. Even if this system could be obtained without Applicant's specification, though Applicant strongly maintains it cannot be so obtained, the combination still fails to forward *the* peripheral device HTTP

message from the web server to the backend server as required by claims 1, 6, and 12. This failure arises because the customer using such a system forwards the *content* of a message, but not the message itself. The difference is distinctive because forwarding of the peripheral device HTTP message as required by claims 1, 6, and 12 enables the information gathering and analysis to occur without human intervention. Thus, claims 1, 6, and 12 are patentable over the cited combination of Assauchi, Skaanning, and Wolff. Because claims 2-5, 7-11, and 13-22 include these limitations missing from the cited combination, they are also patentable.

Second Ground of Rejection under 35 USC 103: Whether Webb discloses the missing limitation of peripheral device functionality information with a PostScript function interface in response to a call from a web server as required by claims 4 and 15.

CLAIMS 4 and 15

In the final office action, the Examiner asserts that Webb teaches the use of a PostScript interface to obtain functionality information from a printer in response to a call from a web server executing in a peripheral device. Applicant disagrees as Webb only discloses a printer driver 55 that may be implemented in PostScript. *Webb*, col. 8, lines 37-53. An interface implemented on a tool bar of a host computer may be used to request printer configuration data and the printer driver delivers these data to the interface. *Webb*, col. 8, line 67 to col. 9, line 8. The tool bar interface is not a web server. Therefore, the printer driver does not

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respond to a call from a web server executing in a peripheral. Only by using Applicant's specification as a blueprint can the Examiner conjure a call from the web server of Wolff to the printer driver of Webb. Such use of Applicant's specification is impermissible and, consequently, claims 4 and 15 are patentable over the cited combination.

Third Ground of Rejection under 35 USC 103: Whether Lozano discloses the missing limitation that the peripheral device functionality information in the peripheral device HTTP message from the web server executing in the peripheral includes data in the XML format as required by claims 11 and 22.

CLAIMS 11 and 22

Claims 11 and 22 require the peripheral device functionality information in the peripheral device HTTP message from the web server executing in the peripheral to include data in the XML format. The Examiner asserts that Lozano renders such a limitation obvious. The portion of Lozano cited by the Examiner for teaching XML communication is col. 10, line 25 to col. 12, line 30 and Appendix A. This section, however, does not disclose communication *from* a peripheral, but *to* a client program 100 executing on a client computer coupled to a peripheral. Specifically, printer driver data are provided in an XML format from a printer vendor's database to a program 100 executing on a client computer. *Lozano*, col. 5, lines 4-8. The Examiner fails to show how XML data sent from a vendor's database to a program executing in a client computer can be combined

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with a web server in a peripheral to arrive at a peripheral device message having XML data that is sent from the web server to a web browser. The only teaching that enables the Examiner to argue that a peripheral provides data in an XML format, and, more specifically, to assert that the web server of Wolff can be modified to send a peripheral device message to a web browser that includes data in the XML format is Applicant's specification. Such use of Applicant's specification is impermissible hindsight and cannot properly support the obviousness rejection of claims 11 and 22.

CONCLUSION

As set forth above, the cited references cannot be combined to arrive at the invention set forth in claims 1-22 unless Applicant's specification is used to modify the components of those references. The Examiner has failed to demonstrate that the cited references possess the evidence necessary to construct a *prima facie* case for obviousness. Therefore, the Board of Appeals is respectfully requested to reverse the rejection of pending claims 1-22.

Respectfully submitted,
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